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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/374,577	08/13/1999	FORREST NABORS	34533-51	3935

7590 10/06/2004

ATTEN: GREGORY D. CALDWELL  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
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EXAMINER

CHOULES, JACK M

ART UNIT PAPER NUMBER

2167

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/374,577	Applicant(s) NABORS ET AL. <span style="float: right;">ms</span>	
	Examiner Jack M Choules	Art Unit 2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66, 69 and 73 is/are pending in the application.
- 4a) Of the above claim(s) 1-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-66, 69 and 73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-66, and 69-73 are presented for examination. Claims 1-47 having been withdrawn from consideration. Claims 67 and 68 having been listed as canceled. And claims 71-73 added in the current amendment.

### ***Response to Arguments***

1. Applicant's arguments filed Dec. 11, 2003 have been fully considered but they are not persuasive.
2. To the argument against the 35 U.S.C. 101, the applicant argues that the claim 58-66 being drawn to a propagated signal, which is statutory subject matter as a carrier signal is a statutory article of manufacture.
3. In response to the argument against the 35 U.S.C. 101 the examiner respectfully disagrees the current office position is that "a propagated signal including a carrier wave" is clearly not a statutory article of manufacture as it is not tangible physical matter or embodied thereon.
4. Concerning the rejection under 35 U.S.C. 103(a) of claims 48, 58, and 66 over Rothrock and the Draft Proposal the applicants argue that Rothrock does not detail a "request for quote (RFO)" or narrow a target group or sellers.

Art Unit: 2177

5. In response to the argument against the 35 U.S.C. 103(a) of claims 48-66 and 69-70 over Rothrock and the Draft Proposal the examiner respectfully disagrees as follows: the claim language “to define” or “to further specify” merely set forth an indented use without providing the apparatus steps or other structure capable of providing the wished for results. In short there is no positive recitation that requires the supposed limitation be preformed. The claim merely recites data structure containing non-functional data a that compilations of data or facts merely stored in the data structure thus being nonfunctional descriptive material, being directed to data *Per Se* thus the difference is limited to non-functional descriptive material stored on a machine which cannot render an invention non-obvious for an invention that would otherwise have been obvious (see MPEP 2106 VI note: MPEP 2106 IV B 1 (b) defines nonfunctional descriptive material) further displaying or printing or otherwise recalling the data cannot make functional data that is otherwise non-functional just as playing or printing a song does not make the song functional descriptive material.

6. Concerning the rejection under 35 U.S.C. 103(a) of claims 48-66 and 69-70 over Rothrock and Kozal the applicants argue that Kozol does not detail, “databases directed to the automotive area” or field.

7. In response to the argument against the 35 U.S.C. 103(a) of claims 48-66 and 69-70 over Rothrock and Kozol the examiner respectfully disagrees as follows: although the applicant is correct that Kozol has no discussion directed to the automotive field the area of the claims that is directed to the automotive field is also considered nonfunctional descriptive material the difference being directed to data *Per Se* thus the difference is limited to non-functional descriptive material stored on a machine which cannot render an invention non-obvious for an invention that would otherwise have been obvious (see MPEP 2106 VI note: MPEP 2106 IV B 1 (b) defines nonfunctional descriptive material).

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 58-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed "A computer data signal embodied in a propagated signal including a carrier wave" which is not tangible having no physical characteristics. The body of the claim relates to a data structure so a Data structure Per se appears to be claimed as it is clearly not claimed as embodied in a computer readable media or another physical structure. See Warmerdam, 33 F.3d at 1360-1361 (claim to computer having specific memory held statutory, claim to data structure per se held non-statutory).

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 71-73 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 71-73 recites the limitation "the order" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2177

***Claim Objections***

4. Claim 71-73 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 48, 58, and 69 the request for quote is already listed although not in positive recitation these three claims do not seem to change anything.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 48-66 and 69-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothrock, US Patent Number 5,748,618 in view of Draft Proposal [hereinafter the draft] "An Industry Standard Data Format for the Export and Import of Automotive Customer Leads"** (Note: the draft was provided by the applicant in a IDS provided 13 March 2000 further although the art does not predate CIP priority application number 09/188,863 the subject matter of the claims is not found in that application.)
2. As to claims 48, 58, 69 and 70-73 the Rothrock disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (figure

Art Unit: 2177

3), "a public block" (figure 3, index 310), "a private block" (figure 3, index 302) and the general principle of and blocks sub-blocks and categories and data items (figure 3).

3. The Rothrock not detail delimiters and the specific blocks sub-blocks and categories and data items claimed. The draft describes delimiters (page 6-14); and the specific blocks sub-blocks and categories and data items claimed (page 6-14). No attempted has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non- functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

4. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of the draft with Rothrock because the draft includes personal data (draft page 3) and it would have been obvious to protect this data from public distribution to protect the interests of the client in the system also the draft shows the particular the need to set up databases directed to the automotive area was known and accepted and the necessary elements to include in such a database.

5. As to claims 49, 50, 59, and 60, in the draft delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (page 6-14) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierarchal structure.

Art Unit: 2177

6. As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

7. As to claims 56-66, the draft details XML (page 3).

2. **Claims 48-66 and 69-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Draft Proposal [hereinafter the draft] "An Industry Standard Data Format for the Export and Import of Automotive Customer Leads"** (Note: the draft was provided by the applicant in a IDS provided 13 March 2000 further although the art does not predate CIP priority application number 09/188,863 the subject matter of the claims is not found in that application.)

8. As to claims 48, 58, 69 and 70-73 the draft disclosed the invention substantially as claimed including a data processing system ['DP'] comprising delimiters (page 6-14); and the specific blocks sub-blocks and categories and data items claimed (page 6-14). No attempt has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non-functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

9. The draft proposal does not show public and private as claimed public and private are merely labels for the blocks having no claimed structure to enforce or act upon the labels the label are also considered nonfunctional descriptive material the difference and the difference is



Art Unit: 2177

obvious as discussed in MPEP 2106 VI note: MPEP 2106 IV B 1 (b) defines nonfunctional descriptive material).

10. As to claims 49, 50, 59, and 60, in the draft delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (page 6-14) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierarchal structure.

11. As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

12. As to claims 56-66, the draft details XML (page 3).

**13. Claims 48-66 and 69-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothrock, US Patent Number 5,748,618 in view of Kozol et al. [hereinafter the Kozol] US Patent No. 5,113,341.**

14. As to claims 48, 58, 69 and 70-73 the Rothrock disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (figure 3), "a public block" (figure 3, index 310), "a private block" (figure 3, index 302) and the general principle of and blocks sub-blocks and categories and data items (figure 3).

15. Rothrock does not detail delimiters and the specific blocks sub-blocks and categories and data items claimed. Kozol details delimiters (figure 1) and blocks sub-blocks and categories and data items (figure 1). No attempted has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this

Art Unit: 2177

rearrangement or non-functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

16. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Kozol with Rothrock because the draft includes personal data (draft page 3) and it would have been obvious to protect this data from public distribution to protect the interests of the client in the system.

17. As to claims 49 and 50, the delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (figure 1) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierarchal structure.

18. As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

19. As to claims 56 and 66, Kozol details SGML (abstract) XML is a standard derived from SGML so it would be obvious to also use the features of the Kozol invention with XML, as it would extend to the functionality to the new standard.

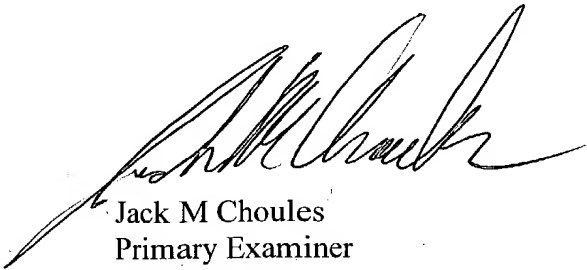
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M Choules whose telephone number is (703) 305-9840; on 22 October 2004 the phone number will change to (571) 272-4109. The examiner can normally be reached on M-F (7:30-4:00).

Art Unit: 2177

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack M Choules  
Primary Examiner  
Art Unit 2177

21 February 2004